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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/398,038	09/17/1999	AKEO MARUYAMA	0557-4774-2	9584
22850	7590	07/02/2004		
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER EBRAHIMI DEHKORDY, SAEID	
			ART UNIT 2626	PAPER NUMBER 13

DATE MAILED: 07/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/398,038

Applicant(s)

MARUYAMA, AKEO

Examiner

Saeid Ebrahimi-dehKordy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5,7-11,13 and 14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5,7-11,13 and 14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

***Response to Arguments***

1. Applicant's arguments with respect to claims 1-5,7-11 and 13-14 have been considered but are moot in view of the new ground(s) of rejection.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-5,7-11 and 13-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Okimoto et al (U.S. patent 6,449,055)

Regarding claim 1,10 and 11 Okimoto et al disclose: An electronic mail transmitting apparatus for transmitting document data via electronic mail, said electronic mail transmitting apparatus comprising: an application program for producing document data (please note column 10 lines 17-23) said application program having a function to send a print instruction to print the document data (please note column 10 lines 23-31) and a printer driver activated by the print instruction of said application program (please note column 10 lines 26-30) said printer driver having a function to convert the document data provided by said application program into a data format processible by

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an application program of an electronic mail receiver and a function to transmit the converted document data via electronic mail (please note column 10 lines 30-39) **where** in the printer driver is capable of selecting the data format suitable for the electronic mail transmission form among the plurality of data formats other than a page description language (PDL) format (please note column 27 lines 27-32).

Regarding claim 2 Okimoto et al disclose: The electronic mail transmitting apparatus as claimed in claim 1, wherein said printer driver transmits the converted document data by attaching to an electronic mail as an attachment file (please note Fig.7, column 14 lines 10-59 where the data and mail header are combined to create the email body)

Regarding claim 3 Okimoto et al disclose: The electronic mail transmitting apparatus as claimed in claim 1, wherein said predetermined data format is a bit-map image format (please note column 22 lines 57-67 and column 23 lines 1-9).

Regarding claim 4 Okimoto et al disclose: The electronic mail transmitting apparatus as claimed in claim 1, wherein said predetermined data format is a document reader software format (please note column 11 lines 45-55).

Regarding claim 5 Okimoto et al disclose: The electronic mail transmitting apparatus as claimed in claim 1, wherein said predetermined data format is a text format (please note column 27 lines 27-32).

Regarding claim 7 Okimoto et al disclose: The electronic mail transmitting apparatus as claimed in claim 1, wherein said predetermined data format is one of a

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hyper text markup language (HTML) format and a standard generalized markup language (SGML) format (please note column 27 lines 26-32).

Regarding claim 8 Okimoto et al disclose: The electronic mail transmitting apparatus as claimed in claim 1, wherein said printer driver has a function to manage information regarding electronic mail addresses (please note column 8 lines 28-41).

Regarding claim 9 Okimoto et al disclose: The electronic mail transmitting apparatus as claimed in claim 1, wherein said printer driver has a function to edit a text of an electronic mail to be transmitted (please note column 12 lines 11-28).

Regarding claim 13 Okimoto et al disclose: The processor readable medium as claimed in claim 11, wherein said third program code means includes program code means for inputting an electronic mail address of a remote party to which the document data is sent via electronic mail (please note column 7 lines 28-40).

Regarding claim 14 Okimoto et al disclose: the electronic mail transmission apparatus as claimed in claim 1, wherein said printer driver includes means for determining the predetermined data format suitable for the electronic mail transmission being performed (please note column 27 lines 33-39).

### **Contact Information**

- Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Saeid Ebrahimi-Dehkordy* whose telephone number is (703) 306-3487.

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The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 5:30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams, can be reached at (703) 305-4863.

**Any response to this action should be mailed to:**

Assistant Commissioner for Patents  
Washington, D.C. 20231

**Or faxed to:**

(703) 872-9306, or (703) 308-9052 (for **formal** communications; please mark  
"EXPEDITED PROCEDURE")


**Or:**

(703) 306-5406 (for **informal** or **draft** communications, please label  
"PROPOSED" or "DRAFT")

**Hand delivered responses** should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application should be directed to the Group Receptionist whose telephone number is (703) 305-4750.

Saeid Ebrahimi-Dehkordy  
Patent Examiner  
Group Art Unit 2626  
June 18 2004



  
KIMBERLY WILLIAMS  
SUPERVISORY PATENT EXAMINER